

REMARKS

By this amendment, no claims have been added or cancelled. Claims 1, 12, 13, and 22 have been amended herein. Hence, Claims 1-22 are pending in the application.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1, 8-9, 12-13, and 20-22 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,496,801 by Veprek et al. ("*Veprek*") in view of U.S. Patent Application Number 2003/0028378 by August et al. ("*August*").

Claims 2-3 and 14-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Veprek* in view of *August* in view of U.S. Patent No. 6,535,854 by Buchner et al. ("*Buchner*").

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Veprek* in view of *August* in view of U.S. Patent Application No. 2002/0010584 by Schultz ("*Schultz*").

Claims 4-7 and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The rejections are respectfully traversed.

CLAIM 1 AND CLAIM 13 ARE PATENTABLE OVER THE CITED ART

Even if *Veprek* and *August* were properly combined, their combination would not teach, disclose, or suggest one or more elements featured in Claim 1 and Claim 13.

Amended Claims 1 and 13 feature the following elements:

“splitting a text into segments that include anticipated-content segments and unanticipated-content segments, wherein each of the anticipated-content segments have previously satisfied criteria for being pre-recorded, and wherein each of the unanticipated-content segments are not within the anticipated-content segments; generating speech for said anticipated-content segments based on pre-recorded sound recordings that correspond to said anticipated-content segments; generating speech for said unanticipated-content segments using speech synthesis; monitoring usage of a particular segment of said segments by said text-to-speech services, wherein said particular segment is one of an anticipated-content-segment and an unanticipated-content-segment; and based on the usage of said particular segment by said text-to-speech services, recategorizing said particular segment to the other of said anticipated-content-segment and said unanticipated-content-segment.”

One of more of the above elements are not disclosed, taught, or suggested by *Vepek* and *August*, either individually or in combination.

NEITHER *VEPEK* NOR *AUGUST* SHOW RECATEGORIZING A PARTICULAR SEGMENT

Claims 1 and 13 each feature the element of “based on the usage of said particular segment by said text-to-speech services, recategorizing said particular segment to the other of said anticipated-content-segment and said unanticipated-content-segment.” Neither *Vepek* nor *August*, either individually or in combination, disclose, teach, or suggest the concept of recategorizing segments from being an anticipated-content-segment to an unanticipated-content-segment, or vice-versa. Further, neither *Vepek* nor *August*, either individually or in combination, disclose, teach, or suggest the concept of recategorizing segments based on the usage of the segments by text-to-speech services.

The position of the Office Action relies upon the fixed portion of the message frame of *Vepek* to be analogous to an anticipated-content-segment, and the variable portion of the

message frame of *Veprrek* to be analogous to an unanticipated-content-segment. However, no portion of *Veprrek* discusses either (a) recategorizing a fixed portion of a message frame as a variable segment of a message frame, or (b) recategorizing a variable portion of a message frame as a fixed portion of the message frame. Thus, the position of the Office Action cannot extend to arguing that *Veprrek* teaches the above-quoted element. Further, *Veprrek* is silent with respect to monitoring the usage of segments by text-to-speech services. Thus, *Veprrek* cannot show this element.

August similarly fails to discuss the concept of recategorizing segments based on the usage of the segments by text-to-speech services. While *August* may teach a text to speech module with a rules module for analyzing the context of selected words of sentences, *August* does not teach (a) monitoring the usage of particular segments by text-to-speech services, and (b) recategorizing segments between being an anticipated-content-segment or an unanticipated-content-segment based on the usage of the segments by text-to-speech services.

Consequently, it is respectfully submitted that this element is not shown, taught, or suggested by the cited art. Therefore, because at least one element of Claims 1 and 13 is not shown, taught, or suggested by the prior art, Claim 1 and 13 are patentable over the cited art and are in condition for allowance.

VEPREK AND AUGUST ARE NOT PROPERLY COMBINED

Moreover, a rejection of Claims 1 and 13 under 35 U.S.C. § 103(a) based upon a combination of *Veprrek* and *August* is improper and may not be sustained. The Office Action, in citing a portion of the cited art that contains a teaching, suggestion, or motivation for combination, states “it would have been obvious to one of ordinary skill at the time of the invention to modify the system of *Veprrek* to implement context and rules modules, as taught by

August, for the purpose of providing more accurate pronunciation of the synthesized words, as suggested by *August* (paragraph 52).”

As stated in the Federal Circuit decision *In re Dembiczak*, 50 USPQ.2d 1617 (Fed. Cir. 1999), (citing *Gore v. Garlock*, 220 USPQ 303, 313 (Fed. Cir. 1983)), “it is very easy to fall victim to the insidious effect of the hindsight syndrome where that which only the inventor taught is used against its teacher.” *Id.* The Federal Circuit stated in *Dembiczak* “that the best defense against subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or suggestion to combine prior art references.” *Id.* Thus, the Federal Circuit explains that a proper obviousness analysis requires “**particular factual findings** regarding the locus of the suggestion, teaching, or motivation to combine prior art references.” *Id.* (emphasis added).

In particular, the Federal Circuit states:

“We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...although ‘the suggestion more often comes from the teachings of the pertinent references’...The range of sources available, however, does **not diminish the requirement for actual evidence**. That is, the **showing must be clear and particular**...Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *Id.* (emphasis added; internal citations omitted).

Nothing in the cited portion of *August* suggests that the approach of *August* could be augmented by a combination with *Veprek*. For example, the cited portion of *August* merely states that (a) TTS module has a rules module for facilitating the conversion of text to speech, and (b) additional lessons may be obtained through input link 20. It is unclear how the TTS module of *August* is compatible with the prosodic and acoustic templates of *Veprek*. Further, it is unclear how adding lessons to a language learning system of *August* would motivate one to combine the language learning system with a speech synthesis system for phrases of multiple

words of *Veprek*. Absent a showing of a teaching or suggestion to combine the teachings, a rejection under 35 U.S.C. § 103(a) is inappropriate hindsight-based analysis. MPEP § 2143.01.

Neither *Veprek* nor *August* show any suggestion, teaching, or motivation to combine their teachings, nor does the Office Action provide a “clear and particular” showing of the suggestion, teaching, or motivation to combine their teachings. In fact, the only motivation provided in the Office Action is the hindsight observation that by combining features of those references, one may achieve the benefits achieved from the invention as described and claimed in the application. It is respectfully submitted that such a hindsight observation is not consistent with the Federal Circuit’s requirement for “particular factual findings.” Accordingly, it is respectfully submitted that any rejection of Claims 1 and 13 under 35 U.S.C. § 103(a) based upon a combination of *Veprek* and *August* is inappropriate because there is no motivation to combine *Veprek* and *August*. Therefore, the rejection may not be sustained and Claims 1 and 13 are in condition for allowance.

CLAIMS 2-12 AND 14-22 ARE PATENTABLE OVER THE CITED ART

Claims 2-12 and 14-22 are dependent claims, each of which depends (directly or indirectly) on one of Claims 1 and 13. Each of Claims 2-12 and 14-22 is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of Claims 2-12 and 14-22 introduces one or more additional limitations that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**NUMEROUS CLAIM REJECTIONS NOT EXPLAINED IN THE OFFICE
ACTION**

It is respectfully submitted that the Office Action, in rejecting Claims 8-9, 12, and 20-22, does not contain any arguments explaining why the claims are allegedly unpatentable under 35 U.S.C. § 103(a) over *Veprek* in view of *August*. If these rejections are to be maintained, then the applicant respectfully requests an explanation as to why Claims 8-9, 12, 20-22 are allegedly unpatentable under 35 U.S.C. § 103(a) over *Veprek* in view of *August*.

CONCLUSION


For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages to Deposit Account No. 50-1302.


Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Christopher J. Brokaw
Reg. No. 45,620

2055 Gateway Place, Suite 550
San Jose, CA 95110
(408) 414-1225
Date: March 22, 2005
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment , Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450	
on <u>March 22, 2005</u>	by  Angelica Maloney